



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,874	10/28/2003	Roberto Polakiewicz	CST-209	3986
<div>7590 12/22/2006 James Gregory Cullem, Esq. Intellectual Property Counsel CELL SIGNALING TECHNOLOGY, INC. 3 Trask Lane Danvers, MA 01923</div>			<div>EXAMINER EWOLDT, GERALD R</div>	
			<div>ART UNIT 1644</div>	<div>PAPER NUMBER</div>
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	12/22/2006	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/694,874

Applicant(s)

POLAKIEWICZ ET AL.

Examiner

G. R. Ewoldt, Ph.D.

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 and 11-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1644

DETAILED ACTION

1. Applicant's election with traverse of Group I, Claims 1-5, 10, and 16, filed 10/04/06, is acknowledged. Because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 6-9, and 11-15 are withdrawn from further consideration by the Examiner, under 37 C.F.R. § 1.142(b) as being drawn to nonelected inventions.

Claims 1-5, 10, and 16 are being acted upon.

3. The specification is objected to for the following informalities:

A) The disclosure is objected to because it contains embedded hyperlinks and/or other forms of browser-executable code. See, for example, page 3 of the specification. Applicant is required to delete the embedded hyperlinks and/or other forms of browser-executable code. See MPEP 608.01.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-5, 10, and 16 are rejected under 35 U.S.C. 112, first paragraph, because the specification,

while being enabling for an antibody that binds human IRS-1 and IRS-2 when phosphorylated at positions 1101 and 1149 (respectively), and also binds murine IRS-1 and IRS-2 when phosphorylated at positions 1095 and 1138 (respectively),

does not reasonably provide enablement for an antibody that binds human IRS-1 and/or IRS-2 when phosphorylated at positions 1101 and 1149 (respectively), and also binds murine IRS-1 and/or IRS-2 when phosphorylated at positions 1095 and 1138 (respectively).

The specification disclosure is insufficient to enable one skilled in the art to practice the invention as claimed without

Art Unit: 1644

an undue amount of experimentation. Undue experimentation must be considered in light of factors including: the breadth of the claims, the nature of the invention, the state of the prior art, the level of one of ordinary skill in the art, the level of predictability of the art, the amount of direction provided by the inventor, the existence of working examples, and the quantity of experimentation needed to make or use the invention, see *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988).

In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) states, "The amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art." "The "amount of guidance or direction" refers to that information in the application, as originally filed, that teaches exactly how to make or use the invention. The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification. In contrast, if little is known in the prior art about the nature of the invention and the art is unpredictable, the specification would need more detail as to how to make and use the invention in order to be enabling" (MPEP 2164.03). The MPEP further states that physiological activity can be considered inherently unpredictable. With these teachings in mind, an enabling disclosure, commensurate in scope with the breadth of the claimed invention, is required.

A review of the instant specification shows that a phosphorylated peptide comprising Ser 1101 of human IRS-1 (CRRRHSS^PETFSST) was used to immunize experimental rabbits, wherein an antibody specific for the phosphorylated protein was generated. The specification discloses that the antibody also binds phosphorylated human IRS-2 (GRRRHSS^PETFSST). The specification further asserts, but does not show, that the antibody also binds murine IRS-1 (CRRRHSS^PETFSAP) and IRS-2 (GRRRHSS^PETFSST). While it is clear that given the close homology of the four proteins a single antibody would be expected to bind all four, the claims are drawn to antibodies that bind various combinations of the proteins: phosphorylated human IRS-1 alone; or phosphorylated human IRS-2 alone; or phosphorylated human and murine IRS-1, but not phosphorylated human and murine IRS-2; or phosphorylated human IRS-1 and murine IRS-2, but not phosphorylated human IRS-2 and murine IRS-1, etc.

Art Unit: 1644

It is unclear how such antibodies could be produced.

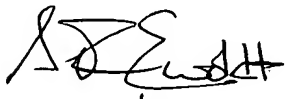
Accordingly, in view of the quantity of experimentation necessary, the lack of sufficient guidance in the specification, the lack of sufficient working examples, i.e., the specification discloses no data demonstrating that the claimed antibodies could be produced, nor even a plausible method for their production, the unpredictability of the art, and the breadth of the claims, it would take undue trials and errors to practice the claimed invention.

6. No claim is allowed.

7. References CJ-CL on the IDS submitted 1/07/04 have been lined through and have not been submitted because they are not in the proper format. See MPEP 609.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (571) 272-0843. The examiner can normally be reached Monday through Thursday from 7:30 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841.

9. **Please Note:** Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.


12/16/06

G.R. Ewoldt, Ph.D.
Primary Examiner
Technology Center 1600